

No. 15,418

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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BERNARD H. STAUFFER,

*Appellant,*

*vs.*

SLENDERELLA SYSTEMS OF CALIFORNIA, INC.,

*Appellee.*

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## APPELLANT'S REPLY BRIEF.

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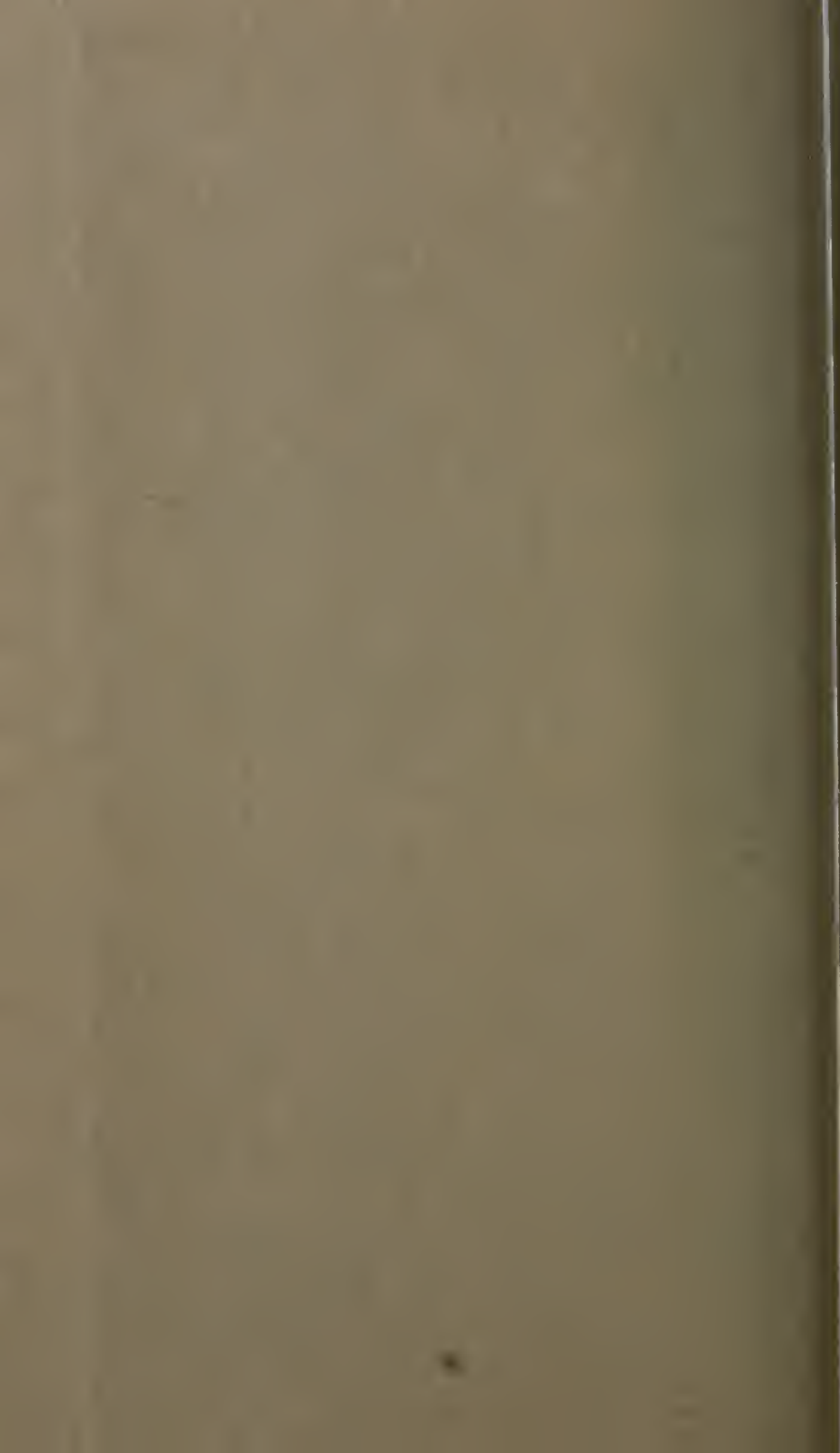
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## TOPICAL INDEX

	PAGE
Stauffer Patent No. 2,240,679 Is Valid.....	1
Finding of Fact 7 Is Clearly Erroneous.....	2
The Prior Art Does Not Achieve the Result of the Patented Combination nor Does It Function in the Same Way.....	4
Parker Patent No. 1,978,223 Does Not Achieve the Result or Function in the Manner of the Patent in Suit.....	4
Miller Patent No. 1,953,424 Does Not Achieve the Result or Function in the Manner of the Patent in Suit.....	5
Gunderman Patent No. 1,825,588 Does Not Achieve the Result or Function in the Manner of the Patent in Suit.....	5
Claim 1 of the Patent in Suit Is Infringed.....	6
Conclusion .....	12

TABLE OF AUTHORITIES CITED

CASES	PAGE
Aluminum Co. of America v. Thompson Products, Inc., 122 F.2d 796 (6 Cir.).....	11
Baker-Cammack Hosiery Mills, Inc. v. Davis Co., 181 F.2d 550 (4 Cir.) .....	11
Consolidated Contract Co. v. Hassam Paving Co., 227 Fed. 439	2
Derman v. Stor-Aid, Inc., 141 F.2d 580 (2 Cir.).....	11
Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U. S. 271 .....	11
Kennedy v. Trimble Nurseryland Furniture, Inc., 99 F.2d 786 (2 Cir.).....	11
Los Angeles Art Organ Co. v. Aeolian Co., 143 Fed. 880, 885 (9 Cir.) .....	11
Oxnard Cannery v. Bradley, 194 F.2d 655.....	2
Page et al. v. Myers, 155 F.2d 57.....	2
Pointer v. Six Wheel Corp., 177 F.2d 155.....	2
Reinharts, Inc. v. Caterpillar Tractor Co., 85 F.2d 628, 633 (9 Cir.) .....	11
Samson-United Corp. v. Sears, Roebuck & Co., 103 F.2d 312 (2 Cir.) .....	8
Sutherland Paper Co. v. Auburn Carton Corp., 118 F.2d 862 (7 Cir.) .....	7
Webster Loom Co. v. Higgins, 105 U. S. 580, 591, 26 L.ed 1177	2
Western States Mach. Co. v. S. S. Hepworth Co., 147 F.2d 345 (2 Cir.) .....	11
Wire Tie Mach. Co. v. Pacific Box Corp., 102 F.2d 543, 107 F.2d 54 .....	2

TEXTBOOK

Walker on Patents, Deller's Edition, Sec. 462.....	7
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## APPELLANT'S REPLY BRIEF.

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### Stauffer Patent No. 2,240,679 Is Valid.

In our opening brief we pointed out that it was error for the District Court to decide, as it did, "that it is so simple that the structure which has been developed here by Mr. Stauffer is a structure which could reasonably be expected to have been developed by one having ordinary skill in that art and that it just does not rise to the level of invention, as invention is protected by the patent laws." [R. 380-1.]

We were somewhat surprised, in view of the District Court's statement concerning the prior art,

"The court cannot see a great deal of similarity between Miller, Gunderman, Parker and Stauffer. They have some things in common, but it cannot be said that these that I have just enumerated anticipate Stauffer in the way that prior art is supposed to anticipate with respect to patent law." [R. 380.],

to see a finding of fact based upon such prior art. But nevertheless Finding 7 is in the record and is the principal reliance of appellee herein. We shall, therefore, demonstrate that it is erroneous.

### Finding of Fact 7 Is Clearly Erroneous.

Finding of Fact 7 reads as follows:

“7. Claim 1 of said Letters Patent No. 2,240,679 in suit defines an assemblage of elements all of which were old in the prior art in which they operated in substantially the same way to produce substantially the same result, and such subject matter as a whole would have been obvious to and could have been produced by any person having ordinary skill in the art to which said subject matter pertains.”

This finding cannot stand if it can be demonstrated that contrary to the finding that the elements in the prior art “operated in the same way to produce substantially the same result” the elements of the patented invention combine to perform an entirely new result in an entirely new way.

The rule announced by the Supreme Court in *Webster Loom Co. v. Higgins*, 105 U. S. 580, 591, 26 L. Ed. 1177, that “where a new combination of old elements produces a new and beneficial result never attained before, it is invention” has been consistently followed by this court:

*Oxnard Cannery v. Bradley*, 194 F. 2d 655;

*Pointer v. Six Wheel Corp.*, 177 F. 2d 155;

*Page, et al. v. Myers*, 155 F. 2d 57;

*Wire Tie Mach. Co. v. Pacific Box Corp.*, 102 F. 2d 543, 107 F. 2d 54;

*Consolidated Contract Co. v. Hassam Paving Co.*, 227 Fed. 439.

Now in our opening brief, we pointed out that the patented combination operates in a certain way to produce a certain result.

This function and result were explained by the inventor as follows:

“Q. With the portion of the body supported on the couch, and a portion of the body, shall we say, the buttocks, being supported on the pad 18, when you reciprocate that arm 20, carrying the pad through the arc indicated in your patent, what happens.” [R. 94.]

\* \* \* \* \*

“The Witness: The applicator that is carrying the weight induces a traction effect on the part of the body that is stationary. The weight of the body carried by the applicator causes a stretching effect between those areas of the body that are stationary, carried by the couch.

“And it is between this action and this weight of the body, carried on the couch, that you get the stretching effect or the traction in the various muscle areas.” [R. 94, 95.]”

And again on rebuttal:

“Q. Is a couch an important part of your device, your patent?”

“A. It is very important because it allows that part of the body that is not on the movable platform to act as an anchor, in which the motion of the platform stretches the muscular tissue between the anchored part and the movable part, thus giving traction (indicating).” [R. 343.]

In our opening brief, we asserted “No prior apparatus which functions in this way or achieves this result has

been produced." This statement remains unchallenged, and perhaps we could rest upon that. We will, however, demonstrate that the art relied upon by appellee does not achieve this result nor function in this way.

**The Prior Art Does Not Achieve the Result of the Patented Combination nor Does It Function in the Same Way.**

The prior art in this case consists of the prior patents to Parker [R. 446], Miller [R. 451] and Gunderman [R. 462] referred to in the quotation from the District Court's oral opinion, *supra*. The other patents in the book of exhibits and referred to on pages 19 and 20 of appellee's brief are in evidence solely to show what was before the Patent Office during the prosecution of the patent in suit. [R. 293.] They are not pleaded as prior art and appellee's reference to them in the manner done in its brief is improper. These other patents will therefore be disregarded here.

**Parker Patent No. 1,978,223 Does Not Achieve the Result or Function in the Manner of the Patent in Suit.**

The essence of the Stauffer System and of the patent in suit is the manipulation of one part of the body, supported upon the applicator 18 of the Stauffer Patent against the weight of the remainder of the body supported on the couch 10. The hoods 17 of Parker are obviously not designed for or capable of supporting or manipulating any portion of the body of the patient. They are designed to give a vibratory massage as close to the spinal process as possible without irritating them. [See R. 466, p. 2, column 2, lines 82-93 of the Parker Patent.]

The word "single" in Claim 1 of the patent in suit was added to the claims to distinguish from Parker's



series of six separate pairs of applicators, each designed to massage a different area along the spine.

Parker could not be used to give a Stauffer (or Slen-derella) treatment. [R. 346.]

**Miller Patent No. 1,953,424 Does Not Achieve the Result or Function in the Manner of the Patent in Suit.**

Miller has a couch for a patient, straps for pulling down on his body and a pad for pushing upwardly. It is a "lymph pump."

The patent states: "\* \* \* The chest and back pads 28 and 27 respectively operate in unison, that is, as the chest straps are pulled downwardly to contract the chest, the back pad 27 simultaneously presses upwardly against the spine."

Concerning this, appellee's expert witness, Dr. Knapp, testified: "I would say the patentee thinks he is getting an upwardly pressing movement." [R. 287.]

Certainly this is not the manipulation of the body described by Mr. Stauffer; it is more like artificial respiration, and the District Court was justified in not finding much similarity to Stauffer.

**Gunderman Patent No. 1,825,588 Does Not Achieve the Result or Function in the Manner of the Patent in Suit.**

Gunderman [R. 462] is a portable vibrating machine. It has no couch, and no gear reduction. [R. 237.] Electric motors as of January 29, 1929 ran 1700-1800 rpm. [R. 282, cross-examination of Dr. Knapp.] Certainly no one would suggest manipulating one portion of the body of a patient against the anchor of the remaining portion of

the body at 1700 rpm, and if you did you would merely shake the body, *i. e.*, vibrate it, and you would not achieve passive exercise.

Thus we are forced to the conclusion that though the individual elements of the Stauffer invention, *i. e.*, couches, slots in the couches, pads, pitmans, motors, etc., may be old in the art, they are assembled to form a new combination which achieves a new result by functioning in a new way.

From the authorities cited above, such a combination involves invention and Finding 7 and Conclusion 2 based thereon are obviously clearly erroneous and should be reversed.

### Claim 1 of the Patent in Suit Is Infringed.

In our opening brief, we demonstrated on pages 13 and 14 how Claim 1 of the patent in suit is read upon and applied to the accused devices. We now find the defendant arguing on specious reasoning that the accused devices, though literally copied by defendant's president, Lawrence Mack, who was a previous manager of plaintiff's operations in Chicago, for one technical reason or another do not infringe. The first of these arguments is based upon the fact that Claim 1 calls for "a single applicator \* \* \* to oscillate \* \* \* axially of the length of said couch like structure."

We fully agree with the defendant that the word "single" in this claim was inserted in order to distinguish from the Parker Patent [R. 446] which shows six pairs of applicators disposed longitudinally of the couch so as to apply massage adjacent the spine longitudinally of the body, and we fully agree that had the defendant used such a device wherein a multiplicity of applicators were thus

arranged in a line, the claim would not be infringed. However, any claim in any patent is entitled to some range of equivalents, and it is fundamental patent law that one may not escape a claim by simply taking an element of the claim, dividing it in half and then locking the two halves together to act as a unit. This is what the defendant has done when it takes the applicator of the patent in suit and divides it in half so as to provide two applicators side by side but both mounted on the same shaft and locked together by a clutch so that they operate in unison. Assuming for instance that the device is used in the buttocks supporting position, this merely means that one ham will be upon one of the applicators and the other upon the other applicator rather than both lying on the single applicator of the patent in suit. The resulting stretching of the muscles, *i. e.*, the resulting passive exercise, is imparted in exactly the same manner. As a result we have a device operating through substantially the same instrumentalities to produce the identical result which is the full meaning of the doctrine of mechanical equivalence.

That such a dividing or duplication or multiplication of parts is ineffective to escape infringement is well decided. *Walker on Patents, Deller's Edition*, Section 462, collects a list of a long series of cases on this point.

Directly in point is the case of *Sutherland Paper Co. v. Auburn Carton Corp.*, 118 F. 2d 862, 864 (7 Cir.). In this case, the claim called for a carton comprising a blank cut and scored in a certain manner to form an egg crate. The defendant took two pieces of paper and glued them together just as defendant in this case takes two applicators and locks them together with a clutch. Concerning this, the Court of Appeals stated:

“Did defendants avoid infringement by using two pieces of paper and gluing them together and thereby

making one piece? For the purpose of determining infringement, defendants' two pieces, glued together, were one piece. Infringement was not avoided by using two pieces and gluing them together."

Also in point is the case of *Samson-United Corp. v. Sears, Roebuck & Co.*, 103 F. 2d 312 (2 Cir.) at 315, wherein the Court held:

"It is no departure from the patent to use a blank of blades instead of single blades or a two-piece hub instead of a one-piece hub to accomplish the same result."

In its clutching at straws, defendant next attempts to build a case for non-infringement out of the fact that the claim calls for the applicator to move axially of the couch. There is no question that the applicators of defendant's tables move longitudinally of the couch rather than transversely, but because of the fact that defendant has split the applicator in half, each half of course from necessity lies equally spaced from the center line of the couch and therefore moves parallel to said center line. That this is the full equivalent of a single applicator having its supporting rod in a plane which bisects the couch longitudinally and is the full equivalent of moving the applicator axially of the couch appears from the testimony of defendant's witness Knapp who testified as follows on cross-examination:

"Q. If I laid a board across those four pads and we were in this first cycle so the supports 11 and 11-A are in unison, would you then say that that board which I have laid across the top is being caused to move axially of the couch?"

"A. I would say the board could be considered to move axially along the couch." [R. 268.]

Defendant's argument next proceeds to seize at the word "flat" in Claim 1 and argues that it avoids infringing this element of the claim because the edges of its applicator are rounded as in the conventional edge of a chair seat. That the functioning parts of defendant's applicators are flat seems to require no further demonstration.

In its final argument with respect to non-infringement, defendant argues that it does not infringe because it does not employ a specific arc of movement detailed in the specification of the patent in suit and specifically claimed in Claim 2 thereof.

It will be noted that Claim 2 is not in issue, the plaintiff having elected to stand on Claim 1, and the record indicates that when both counsel for the appellee and counsel for the appellant attempted to inquire into the niceties of degree of arc employed, the District Court foreclosed this line of inquiry. Thus during the cross-examination of plaintiff's expert, the following took place:

"Q. And the same thing is true as to the location of the pivot point for the little crank that you have put on here in lucite? A difference in the location of that pivot point, even in a small amount, changes materially the arc arrangement in which the red applicator arm moves, does it not?"

"A. To a lesser degree, yes."

"The Court: I don't see these fine points of whether it does or does not are involved here in determining whether Claim 1 of the patent is or is not infringed."

"You might enlighten me, if I am just dense in not getting your point, but I can't see what you are driving at because it doesn't seem that Claim 1 relates at all to this subject, as to the fine points of it."

[R. 181.]

And in the cross-examination of defendant's expert, the following took place:

"Q. No, this is 17, that is correct. This drawing with the support being straight up in the air—I am talking about Section CC,—

"A. Yes.

"Q. —the maximum eccentricity is straight down, right?

"A. No, I don't know; this kind of a drawing I cannot tell on.

"The Court: *Would that make any difference under Claim 1 of this patent?*

"Mr. Lyon: I don't think so, sir, but what I am doing now is I am defending my exhibits. I am not worrying about the patent.

"The Court: But I am. That is what I have to decide, the patent and the accused structure, and it seems to the court that the claim of the patent does not call for all of this elaboration of matters which might be one way or the other and still be within that claim.

"Mr. Lyon: I agree with you. I won't belabor that any more." (Emphasis our own.) [R. 274, 275.]

The foregoing shows that the degree of arc through which the applicator is oscillated was not considered by the District Court to be at all pertinent to the question of infringement of Claim 1 of the patent. In this, the District Court was absolutely correct. It is significant that no mention of such degree of arc is made in Claim 1 but that Claim 2 (not in suit) specifically limits the arc to from 80° to 90°. It is well settled that in construing and applying the claims of a patent, a limitation which appears in a claim not before the court will not be read into a claim

in which it does not appear. This is established by a uniform series of cases:

*Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 F. 2d 628, 633 (9 Cir.);

*Los Angeles Art Organ Co. v. Aeolian Co.*, 143 Fed. 880, 885 (9 Cir.);

*Baker-Cammack Hosiery Mills, Inc. v. Davis Co.*, 181 F. 2d 550 (4 Cir.);

*Western States Mach. Co. v. S. S. Hepworth Co.*, 147 F. 2d 345 (2 Cir.);

*Kennedy v. Trimble Nurseryland Furniture, Inc.*, 99 F. 2d 786 (2 Cir.);

*Derman v. Stor-Aid, Inc.*, 141 F. 2d 580 (2 Cir.);

*Aluminum Co. of America v. Thompson Products, Inc.*, 122 F. 2d 796 (6 Cir.).

As stated by the Supreme Court of the United States in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271 at 277: "It would accomplish little to require that claims be separately written if they are not to be separately read." It follows, therefore, in construing Claim 1 of the patent in suit the District Court was correct in refusing to consider the degree of arc of Claim 2 as being part of Claim 1, and, therefore, the appellee's argument on pages 30-32 of its brief concerning this motion must fail.

In summary, therefore, it is respectfully submitted that on the issue of infringement appellant has demonstrated that each and every element of Claim 1 of the patent in suit is present either in its exact form or by a full mechanical equivalent in the accused devices, functioning in the same manner to produce the same result. This is infringement.

### Conclusion.

In conclusion it is respectfully submitted that the Stauffer Patent in suit operates in an entirely new way and produces an entirely new result and, therefore, embodies a meritorious and patentable invention and that Finding of Fact No. 7 of the District Court is clearly erroneous.

It is further submitted that Claim 1 of the patent in suit is obviously infringed and that this Court should enter a judgment reversing the District Court and directing the entry of judgment that Claim 1 of Stauffer Patent No. 2,240,679 is valid and has been infringed by the defendant.

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